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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,690	12/04/2001	Richard Wojdyla	5384/55373	9872
7590	07/11/2007		EXAMINER	
KEITH E. GEORGE, ESQ. McDERMOTT, WILL & EMERY 600 13th STREET N.W. WASHINGTON, DC 20005-3096			LE, UYEN CHAU N	
			ART UNIT	PAPER NUMBER
			2876	
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			07/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/007,690	WOJDYLA ET AL.	
	Examiner	Art Unit	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 25 June 2007.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-4, 8-18, 21, 22 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 8-18, 21, 22, 24-33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Requesting Continued Examination (RCE)*

1. Receipt is acknowledged of the Requesting Continued Examination (RCE) filed 06/25/2007.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4, 9-10, 12-14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Cordery et al (US 6,073,125).

Re claims 1-2, 4, 9-10, 12-14 and 16: Cordery et al discloses a method for providing trace-ability of mail pieces, comprising the steps of: creating a plurality of mail pieces 104; providing a first tracing code (i.e., encrypted indicia 108) on each of the plurality of mail pieces 104 (col. 3, lines 30-32 and lines 53-56); creating a mailing statement 106 for the plurality of mail pieces 104 (fig. 1; col. 3, lines 50+); providing a second tracing code 312 on the mailing statement 106 (fig. 3; col. 3, lines 32+ and col. 5, lines 7-45); and submitting the plurality of mail pieces to a postal service facility (col. 4, lines 52+); wherein the first tracing code is encrypted (col. 3, lines 28+); wherein the first tracing code is independent from a meter imprint (i.e., the first tracing code is encrypted by utilizing a random digital token key  $K_m$ ); various mail pieces

are delivered to a carrier acceptance unit 116 along with statements of the mailing, which can be in hard copy form or electronic form, where the first tracing code 108 on each of the mail pieces and the second tracing code on the statements of mailing are verified via an acceptance unit scanner (col. 4, lines 1-31); verifying that the encrypted mail producer/creator tracing code corresponds to a mail producer/creator tracing code (fig. 5; col.6, lines 34-55). The first tracing code 108 related to various information including origin postal code, which can be traced even in the event the mailer deposited mail in different locations or used various carrier services in sending mail to various recipients (fig. 2; col. 4, lines 42-58), thus the first tracing code 108 corresponding to a mail producer/creator of the mail pieces and can be traced back to the original location/mail producer/creator via the origin postal code upon reading the first tracing code 108. The second tracing code 312 is the encryption by utilizing the digital key  $K_m$  with the public key of the acceptance unit  $P_{AU}$ , which used to verify the first tracing code/indicia 108 printed on the mail-piece (fig. 3; col. 5, lines 20-31), therefore the second tracing code 312 corresponding to the producer/creator of the mail pieces; wherein the step of providing a first tracing code on each of said plurality of mail pieces includes the step of passing each of said plurality of mail pieces through tracing code producing equipment, independent of a meter (fig. 2; col. 4, line 37 through col. 5, line 6). Since both the first code 108 and the second code 312 contain a digital token  $K_m$  (col. 3, lines 53-56 and fig. 3), and the digital token  $K_m$  is corresponding to a mailer who generates a mailing together with a statement of mailing including generating the digital  $K_m$  (col. 3, lines 28-36), the mailer or mail producer/creator is identified readily via the first and second codes (see vault 114 of fig. 1).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al in view of Clark et al (US 4829568 A). The teachings of Cordery et al have been discussed above.

Re claim 3: Cordery et al has been discussed above, but is silent with respect to the first tracing code corresponds to the characteristics of the mail pieces.

Clark et al teaches a package having a postage indicia imprint supported thereon relating to a characteristic of the package (claim 11).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the tracing code of Cordery et al to further include at least a characteristic of the mail piece as taught by Clark et al in order to provide Cordery et al with a

more accurate system wherein the correct mail piece can be confirmed instantaneously upon reading the first tracing code (i.e., based on the included characteristic of the mail piece).

7. Claims 8, 15, 18, 21, 22, 24, 25, 27-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al in view of Simon (US 20030085266 A1). The teachings of Cordery et al have been discussed above.

Re claims 8, 15, 18, 21, 22, 24, 25, 27-28 and 30-31: Cordery et al has been discussed above, but is silent with respect to capturing and recording an identity of an individual submitting at least one mail piece.

Simon teaches a mail-collection receptacle equipped with a receiver 3, which performs the two-fold function of capturing a digital photographic image of an individual piece of mail 2 being deposit into the mail-collection receptacle 1 and the face of a person making the deposit (figs. 1 & 2; paragraph [0032]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a camera of Simon into the system as taught by Cordery et al in order to provide Cordery et al with a more secure system in the actual mailer/sender of suspicious/harmful mails can be identified/traced instantly upon detection of the suspicious/harmful mails via the record of the mails submitter's identity (i.e., his photograph).

8. Claims 11, 17, 26, 29 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al as modified by Simon as applied to claim 1 above, and further in view of Pintsov (US 6,009,416). The teachings of Cordery et al as modified by Simon have been discussed above.

Re claims 11, 17, 26, 29 and 32-33: Cordery et al/Simon have been discussed above but is silent with respect to providing an alert indication when the first tracing code does not correspond to the second tracing code.

Pintsov teaches a suitable investigation can be implemented when information obtained from a scanned mail piece does not match with the correspond statement of mailing (col. 11, lines 24+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further perform an investigation process when the first tracing code does not match the second tracing code as taught by Pintsov to provide Cordery et al/Simon with a more secure system wherein any suspicious mails can be notified, stopped and/or investigated immediately, preventing any harmful (e.g., anthrax, etc.) mails from being further processing in the event of terror.

#### *Response to Arguments*

9. Applicant's arguments filed 04/26/2007 have been fully considered but they are not persuasive.

10. In response to the Applicant's argument with respect to the broadly interpretation of the "source" (p. 10-13), the Applicant further specified the "source" of the mail pieces as being the "mailer" or the "mail producer" throughout the specification of the application (p. 12), the Examiner respectfully submits that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. In response to the Applicant's argument with respect to the new amended claims, which include a mailer, mail producer or mail creator (p. 14, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs), the Examiner respectfully disagrees and requests the Applicant to further review Cordery et al wherein both the first code 108 and the second code 312 contain a digital token K<sub>m</sub> (col. 3, lines 53-36 and fig. 3), and the digital token K<sub>m</sub> is corresponding to a mailer who generates a mailing together with a statement of mailing including generating the digital K<sub>m</sub> (col. 3, lines 28-36), the mailer or mail producer/creator is identified readily via the first and second codes (see vault 114 of fig. 1).

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Stadermann (US 6701215 B1); Ogg (US 20020046196 A1); Montgomery et al (US 20030101148 A1); Masuko (JP 2002355613 A); and Fitzsimmons (US 20070022060 A) are cited as of interest and illustrate a similar structure to a METHOD AND SYSTEM FOR MAIL SECURITY AND TRACEABILITY.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on M-F 5:30AM-2PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Uyen-Chau N. Le  
Primary Examiner  
Art Unit 2876

January 10, 2007